

Appl. No. 10/604,495  
Response Dated December 5, 2005  
Reply to Office Action Dated October 5, 2005

### REMARKS/ARGUMENTS

Please reconsider the application in view of the above amendments and the following remarks. Claims 1-56 remain in this application. Claims 2-16, 22, 36-47, 50, 51 and 54 have previously been withdrawn from consideration.

A minor amendment to claims 1 and 52 are presented herein for the sake of clarity. In particular, the phrase "adapted to" was removed from these claims. Additionally, the phrase "such that" was added to claim 1 to clarify that the arm blocks debris after it is released. Support for this amendment is found, for example at paragraph [0062]. It is submitted that these amendment contain no new matter and merely place the claims in a better condition for allowance.

#### Examiner Interview

On December 1, 2005, Attorneys Jennie Salazar and Steve Christian spoke with the Examiner concerning the rejections set forth in the Office Action dated October 5, 2005. No agreement was reached concerning the Interview. As requested by the Examiner, Applicant has prepared the response below to clarify the position concerning the claims.

#### Rejection(s) under 35 U.S.C § 102

Claims 23-28, 34, 48, 49, 52, 53, 55, and 56 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,772,839 ("Bond"). These rejections are respectfully traversed because the cited Bond reference fails to describe "each and every element as set forth

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in the claim,” as is required for a proper anticipation rejection. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 23 recites “positioning the bit in the perforation to block debris as formation fluid flows from the perforation into the downhole tool whereby contamination is reduced in the formation fluid collected in the downhole tool.” Claim 52 as amended similarly recites “positioning at least one debris blocker in the perforation via the arm to prevent debris from flowing into the downhole tool as formation fluid flows through the perforation into the downhole tool.” Thus, claims 23 and 52, along with the claims that depend therefrom, require the positioning of a bit/debris blocker in the perforation to block or prevent debris from flowing as formation fluid flows from/through the perforation into the downhole tool.

The claimed invention relates to the recognition that the presence of debris (e.g., mud, dirt, contaminants) in a wellbore perforation compromises the ability to sample representative formation fluids via the perforation, and the solution of employing a bit or debris blocker to reduce contamination in the sampled fluid. *See, e.g., Paragraphs [0008] through [0010]*. As shown in Figs. 8 and 9, the bit or debris blocker is positioned in the perforation to allow fluid to flow into the downhole tool while blocking debris. Bond, on the other hand clearly fails to recognize the problem of perforation-sampled fluid being contaminated by the presence of debris. Accordingly, Bond fails to teach or suggest – in any sense – a solution to this problem. Moreover, Bond teaches away from such debris blocking provides a helical groove (100) in the piercing member (90) specifically designed to **facilitate the flow of flowable material**. *See, Bond, Col. 12, lines 51-53 and Fig. 3*. Thus, such a helical groove is provided to enhance flow, not block debris.

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The Examiner suggests that the piercing member (90) of Bond as being extendable from a downhole tool for positioning "in the perforation to block debris" (*Office Action, page 2*). The Examiner also states that the piercing member (90) of Bond "will block some debris that is too big to fit past the helical grooves or holes" provided therein" (*Office Action, page 6*). Since Bond itself makes no recognition whatsoever of the alleged debris-blocking characteristics, the Examiner appears to rely on the inadvertent or accidental blocking of debris by Bond as being sufficient to anticipate the noted elements of the claimed invention. The Applicant respectfully submits that such reliance is contrary to established legal precedent. In particular, it is well settled law that an accidental or inadvertent achievement of a claimed product or process does not constitute an anticipation of that claimed product or process. *In re Robertson*, 169 F.3d 743, 745 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (Anticipation "may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstance is not sufficient."); *Tilghman v. Proctor*, 102 U.S. 707 (1881) (accidental and unwitting production of a certain process did not constitute anticipation); *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45 (1923) ("accidental results, not intended and not appreciated, do not constitute anticipation").

Bond further teaches away from debris blocking by describing the use of its piercing member (90) as establishing part of "a continuous flow path" through which "flowable material may be flowed between the surface and the selected area outside the well casing." *See Bond, Col. 1, lines 64-67 and col. 12, lines 45-53*. In an exemplary operation described by Bond, called a "squeezing operation," the helical groove (100) of the piercing member (90) is used to conduct cement through the perforation and into an annulus outside the well casing. *See Bond,*

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*Col. 12, lines 53-57.* Cement would represent, e.g., by its likely inclusion of aggregates, the sort of contamination that the present invention seeks to reduce. Thus, the groove of Bond would permit the flow of the type of debris that the present invention intends to prevent from entering the downhole tool.

In view of the above, it is submitted that the cited art fails to present *prima facie* cases of anticipation. The Applicant therefore requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 102.

#### **Rejection(s) under 35 U.S.C § 103**

Claims 1 and 17-21, 29-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of MacDougall, Bond, Urbanoskiy, Taggart and/or Brieger.

These rejections are respectfully traversed because the Examiner has failed to present a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143. At least one of these criteria – and probably all three – is lacking, as explained below.

To properly support a proffered combination of references, a patent examiner “must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them” in the proffered manner. *In re Rouffet*, 149 F.3d at 1359.

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Close adherence to this rigid methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *Dembiczak*, 175 F.3d at 999 (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)). The Applicant submits that there is insufficient support for the proffered combinations.

Claim 1 as amended recites, *inter alia*, at least one debris blocker positionable in the perforation via the arm and releasable therein such that the at least one debris blocker prevents debris from flowing through the perforation and into the housing with a formation fluid whereby the contamination in the formation fluid is reduced. This amendment clarifies that the debris blocker is released into the perforation to prevent the debris from flowing through the perforation. It is submitted that this amendment clarifies the claim and provides no new matter.

As discussed above, Bond fails to teach a debris blocker at all. MacDougall, Urbanosky, Taggart and Brieger also fail to provide debris blockers. Moreover, the Examiner concedes that MacDougall fails to provide a releasable debris blocker. The Examiner attempts to use Bond to provide the deficiencies of MacDougall. However, since Bond fails to provide a debris blocker and teaches away from debris blocking, Bond fails to provide the missing limitations. The Examiner suggests that Bond teaches a debris blocker that is releasable, but when the piercing member (90) of Bond is released, it actually **plugs** the perforation and prevents any flow therethrough. *See Bond, Figs. 18 and 19*. The piercing member of Bond, therefore, fails to block debris and actually prevents the flow of fluid that is required in Claim 1. Thus, the combination of Bond and MacDougall fails to provide the invention as recited in Claim 1.

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Moreover, there is no motivation to combine Bond with MacDougall to achieve Applicant's invention. Neither reference even contemplates the problem of contamination in the perforation. Even if one were to attempt to combine the references, then the combination would, at most an dif at all, teach the use of a piercing member that plugs. The combination would still fail to provide a releasable debris blocker in the perforation which would block debris as fluid flowed into the downhole tool as recited in Claim 1. Urbanosky, Taggart and Brieger also fail to teach a debris blocker as recited and fail to provide the deficiencies of Bond and/or MacDougall. Thus, none of the art of record alone or in combination teaches, discloses or even suggests the claimed invention.

For at least these reasons, the Applicant submits that the Examiner has failed to establish a prima facie case of obviousness under 35 U.S.C. § 103. Applicant, therefore, respectfully requests reconsideration and withdrawal of the claim rejections.

Applicant believes this reply to be fully responsive to all outstanding issues and place this application in condition for allowance. Accordingly, Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If this belief is incorrect, or other issues arise, please do not hesitate to contact the undersigned at the telephone number listed below.

This paper is submitted in response to the Office Action dated October 5, 2005, for which the three-month date for response is January 5, 2006. This response is also submitted within the two-month date for an advisory action, namely by December 5, 2005. No extension of time fees are believed to be due. However, please apply any fees or charges not covered, or any credits due, to Deposit Account 19-0610 (Reference Number 20.2771).

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Respectfully submitted,

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